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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/743,925

12/23/2003

Michael Tune

Tune 001

2835

55959

7590

04/04/2007

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EXAMINER

JACKSON, BRANDON LEE

ART UNIT

PAPER NUMBER

3772

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/04/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/743,925

Applicant(s)

TUNE, MICHAEL

Examiner

Brandon Jackson

Art Unit

3772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>03/01/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to amendments/arguments submitted on 03/01/2007.

Currently, claims 1-19 and 21 are pending in the application.

Response to Arguments

Applicant's arguments, see Page 2, Lines 5-30, filed 03/01/2007, with respect to the rejection(s) of claim(s) 1 under 102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Phelps (U.S. Patent 4,821,742).

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered. **All the references listed in the specification must be included in the Information Disclosure Statement on a separate sheet.**

Specification

The abstract of the disclosure is objected to because there is a "32" after the final period. Correction is required. See MPEP § 608.01(b). **The correction should be**

submitted on a separate sheet, completely displaying the new abstract and changes to the specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-3, 7-11, and 13-18 rejected under 35 U.S.C. 103(a) as being unpatentable over Friedman (U.S. Patent 5,421,350) in view of Phelps (U.S. Patent 4,821,742). Friedman discloses a contraceptive prophylactic condom (10) comprising a closed end (16) and an open end (32) opposite the closed end, an intermediary portion (20) between the ends generally in a frusto-conical shape (fig. 1), wherein the open end forms a leak proof enclosure of its periphery about the glans penis portion, wherein said condom contains a securing means effective to maintain a non-movable position (col. 6, lines 7-11). The condom comprises a seminal receptacle (18), which is composed of an

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impervious material (col. 6, lines 26-29). The term "impervious" has been given its broadest most reasonable definition, which is to not permit passage a substance. This is equivalent to a leak-free seal. Further, Friedman discloses a pressure sensitive medical grade adhesive (22) means (col. 6, lines 61-62), wherein the adhesive (22) is viralcidal, bactericidal, myocidal, hypoallergenic, and made or organic substance (col. 8, lines 6-9). Moreover, the condom (10) is manufactured from latex rubber (col. 6, lines 57-59) and comprises an electrometric band (12) around the periphery of the closed end (16) and effective to form lea-proof annular seal around the circumference of a portion of the glans penis (col. 6, lines 26-29). Friedman fails to disclose that the periphery of the device is just above the sulcus of the glans penis.

However, Phelps discloses a contraceptive device (2) comprising a seal periphery just above the sulcus of the glans penis. Therefore it would be obvious to one of ordinary skill in the art at the time of the invention to modify the Friedman device to only extend to just above the sulcus, because it allows the sensitive region to be exposed and give the user greater pleasure during sexual acts.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Friedman (U.S. Patent 5,421,350) and Phelps (U.S. Patent 4,821,742) in view of Vistins (U.S. Patent Application Publication 2003/0124354). Friedman/Phelps substantially discloses the inventions claims, see claim 1 rejection above, however Friedman/Phelps fails to disclose a condom composed of colored material. However, Vistins teaches a colored polymeric material for use in a condom (par. 0008, lines 1-2). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the

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condom material of Friedman/Phelps to have the colored material of Vistins to provide aesthetically pleasing condoms of varying colors.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Friedman (U.S. Patent 5,421,350) and Phelps (U.S. Patent 4,821,742) in view of Hopkins et al. (U.S. Patent 5,449,486). Friedman/Phelps substantially discloses the invention as claimed, see claim 1 rejection above, however Friedman/Phelps fails to disclose a flavoring means for the condoms. However, Hopkins teaches a flavored oral prophylactic (col. 2, lines 63-66). Therefore, it would have been obvious to one of ordinary skill in the art to modify the condom material of Friedman/Phelps to have the flavoring of as taught by Hopkins in order to avoid the undesirable taste of latex for the user.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Friedman (U.S. Patent 5,421,350) and Phelps (U.S. Patent 4,821,742) in view of Ellington et al. (U.S. Patent 6,593,309). Friedman/Phelps substantially discloses the invention as claimed, see claim 1 rejection above, however Friedman fails to disclose a condom having a delivery means for delivering substances selected from aspirin or analgesics, vitamins, neutraceuticals, antacid, nicotine, caffeine and stimulants and/or combination thereof. However, Ellington teaches a lubricant, which can be used in conjunction with condoms, that can have vitamin E, caffeine, or other stimulants (col. 5, lines 47). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the condom of Friedman/Phelps to include the lubricant

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of Ellington in order to lubricate the condom and for smoother intercourse, while delivering one of a desired stimulant, such as vitamin E (etc).

Claim 12 rejected under 35 U.S.C. 103(a) as being unpatentable over Friedman (U.S. Patent 5,421,350) and Phelps (U.S. Patent 4,821,742) in view of Manning (U.S. Patent Application Publication 2004/0194786). Friedman/Phelps substantially discloses the invention as claimed, see claim 1 and 7 rejections above, however Friedman/Phelps fails to disclose spermicidal adhesive. However, Manning teaches a condom including a spermicidal adhesive (par. 0035, lines 1-4). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to substitute the adhesive of Friedman/Phelps the spermicidal adhesive that taught by Manning because it provides more protection for the users against pregnancy.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Friedman (U.S. Patent 5,421,350) and Phelps (U.S. Patent 4,821,742) in view of Winkler (U.S. Patent 6,098,625). Friedman/Phelps substantially discloses the invention as claimed, see claim 1 rejection above, however Friedman/Phelps fails to disclose that the condoms made of an absorbent material. However, Winkler teaches a prophylactic with made of absorbent material (col. 3, lines 29-34). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the material of the tip of the condom of Friedman/Phelps with the absorbent material as taught by Winkler, because the prophylactic would then absorb the ejaculate and prevent it from secreting into the non-wearer of the prophylactic.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Friedman/Phelps as applied to claim 1 above, and further in view of Manning (U.S. Patent 6,298,852). Friedman/Phelps fail to disclose an elastomeric band around the periphery of the open end. However, Manning teaches a condom (1) comprising an elastic band (7). Therefore, it would be obvious to one of ordinary skill in the art at the time of the invention to modify the Friedman/Phelps with a elastic band (7) in order to more securely hold the condom on and allow it to be rolled onto the penis.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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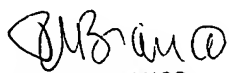
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brandon Jackson whose telephone number is (571)272-3414. The examiner can normally be reached on Monday - Friday 8-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco can be reached on (571)272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Brandon Jackson
Examiner
Art Unit 3772

BJ


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8/31/07